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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,659	04/08/2004	Gregory S. Kelley	1001.1755101	8007

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EXAMINER

KOHARSKI, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3763

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,659

Applicant(s)

KELLEY, GREGORY S.

Examiner

Christopher D. Koharski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 19-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/12/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 19-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group (group I selected), there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/20/2006.

Information Disclosure Statement

The information disclosure statement (IDS) that was submitted on 7/21/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4 and 7 rejected under 35 U.S.C. 102(e) as being anticipated by Deniega et al. (US2004/0064129). Deniega et al. discloses a catheter for uniform delivery of medication.

Regarding claims 1-4 and 7, Deniega et al. discloses a medical device comprising a first component (282) having an outer surface including an outer engagement portions, a second component (280) having an inner surface including an inner engagement portion wherein the inner engagement portion configured to fit over the outer engagement portion and an aerated adhesive layer ([0107-0109]) positioned between the inner engagement portion and the outer engagement portion. The adhesive layer is prepared and dried in an ambient environment and thus inherently has some void spaces and is capable of a having distensible regions within the adhesive layer (see figure 26A).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5-6 are rejected under 35 U.S.C 103(a) as being unpatentable over Deniega et al. in view of Ferrera et al. (US2001/002666). Deniega et al. meets the claim limitations as described above except a light curable epoxy aerated adhesive.

However, Ferrera et al. teaches a variable stiffness optical fiber shaft.

Regarding claims 5-6, Ferrera et al. teaches catheter components that are assembled with an aerated light curable epoxy adhesive ([0014]).

At the time of the invention, it would have been obvious to use the adhesive of Ferrera et al. to assemble the catheter of Deniega et al. because the light curable adhesive allows for increased joining flexibility. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Ferrera et al.

Claim Rejections - 35 USC § 103

Claims 8 and 13 are rejected under 35 U.S.C 103(a) as being unpatentable over Deniega et al. in view of Ferrera et al. (US2001/002666). The modified Deniega et al. meets the claim limitations except for the specific voids and densities.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the aerated-adhesive with the void space and density as claimed by Applicant for optimal joining performance, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim Rejections - 35 USC § 103

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Deniega et al. in view of Jauchen et al. (6,180,544). Deniega et al. meets the claim limitations as described above except for the specific voids filled with inert N₂ gas and various pressures.

However, Jauchen et al. teaches an air-permeable substrate material with a self-adhesive coating process for its production and its use.

Regarding claims 9-12, Jauchen et al. teaches the use of an adhesive process to assemble medical devices that uses various noble gases (N₂) and discusses various pressure and joining temperatures (cols 1-2).

At the time of the invention, it would have been obvious to use the adhesive of Jauchen et al. with the catheter of Deniega et al. because the adhesive allows for improved joining. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Jauchen et al.

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Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the adhesive at the specific pressure, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim Rejections - 35 USC § 103

Claims 14-15 are rejected under 35 U.S.C 103(a) as being unpatentable over Deniega et al. Deniega et al. meets the claim limitations as described above except for the specific adhesive layer thickness.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the adhesive layer to desired thickness for optimal joining and reliability, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

Claim Rejections - 35 USC § 103

Claims 16-18 are rejected under 35 U.S.C 103(a) as being unpatentable over Deniega et al. in view of Klima et al. (US2001/0020161). Deniega et al. meets the claim limitations as described above except for the specific catheter components.

However, Klima et al. teaches a catheter support structure.

Regarding claims 16-18, Klima et al. teaches a catheter with a hub (12), strain relief (22), and elongate shaft (20) (see Figure 1).

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At the time of the invention, it would have been obvious to incorporate the strain relief and hub of Klima et al. to the system of Deniega et al. in order to allow for catheter reliability and strain control. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Klima et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Flannigan et al. (US2003/0077423).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 1/25/07



Christopher D. Koharski
AU 3763

